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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,055	02/03/2004	Reinhard Heinrich Hohensee	IBMN.004US01 (0502)	1532
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DAVID W. LYNCH CHAMBLISS, BAHNER & STOPHEL 1000 TALLAN BUILDING-T TWO UNION SQUARE CHATTANOOGA, TN 37402			EXAMINER KIM, PAUL	
			ART UNIT	PAPER NUMBER
			2161	
			MAIL DATE	DELIVERY MODE
			07/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/771,055

**Applicant(s)**

HOHENSEE ET AL.

**Examiner**

Paul Kim

**Art Unit**

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date, \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office action is responsive to the following communication: Amendment filed on 12 April 2007.
2. Claims 1-18 and 26 are pending and present for examination. Claims 1 and 26 are in independent form.

### ***Response to Amendment***

3. Claims 1 and 26 have been amended.
4. No claims have been cancelled.
5. No claims have been added.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claim 18** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 18 recites the negative limitation of "downloading the object without generating an error" which does not have basis in the original disclosure. For the purposes of this examination, prior art will not be applied to the present claim until further clarification is provided.

Art Unit: 2161

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1-17 and 26** are rejected under 35 U.S.C. 102(b) as being anticipated by Seto et al (U.S. Patent No. 5,546,572, hereinafter referred to as SETO), filed on 25 August 1992, and issued on 13 August 1996.

10. **As per independent claims 1 and 26**, SETO teaches:

A method for processing referenced objects, comprising:

referencing an object by selected indicia, the selected indicia being a name, a globally-unique identifier or a globally-unique identifier and an object locator {See SETO, C17:L51-61, wherein this reads over "[w]ith this command, the latitude and longitude of Shinjuku Station are retrieved from the object table by using the object name as a search key"};

searching for the object by the selected indicia {See SETO, C17:L51-61, wherein this reads over "[w]ith this command, the latitude and longitude of Shinjuku Station are retrieved from the object table by using the object name as a search key"};

downloading the object having the selected indicia {See SETO, C17:L62-65, wherein this reads over "[i]f the object name is present, the next image retrieving step 1010 is executed"};

analyzing the downloaded object to identify the selected indicia of the downloaded object {See SETO, C17:L66-C18:L9, wherein this reads over "a sensed image 1030 shown in FIG. 29 is retrieved while referring to an image table shown in FIG. 28, and while checking the inclusion relation as to whether Shinjuku Station is included within the image"};

capturing the object in persistent memory when the selected indicia is identified to include a globally-unique identifier.

Additionally, the step of "capturing the object in persistent memory" is optional since, wherein the selected indicia is a name, the selected indicia would then fail to include a globally-unique identifier. Therefore, because the aforementioned step is optional, the step will not be afforded further consideration for the purposes of this Office action as Examiner has selected that the selected indicia be "a name."

Art Unit: 2161

11. **As per dependent claim 2**, SETO teaches:

The method of claim 1 wherein the referencing of the object is by an object name and the searching for the object is performed by object name {See SETO, C17:L51-61, wherein this reads over "[w]ith this command, the latitude and longitude of Shinjuku Station are retrieved from the object table by using the object name as a search key"}.

12. **As per dependent claims 3-17**, wherein the independent claim optionally recites "a globally-unique identifier" and "a globally-unique identifier and an object locator" and the present claims recite an object that is referenced with said identifiers, the claims will not be further considered nor will prior art be applied.

***Response to Arguments***

13. Applicant's arguments filed 12 April 2007 have been fully considered but they are not persuasive.

a. Rejections under 35 U.S.C. 112

Applicant asserts the argument that the specification provides sufficient support and description regarding the recited limitation within claim 18 of "downloading the object without generating an error." The Examiner respectfully disagrees in that claim 18 is directed to "downloading the object without generating an error when a capture storage is full." However, it is noted that the features upon which applicant relies (i.e., deleting resources to make room to capture downloaded objects) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, wherein claim 18 fails to recite the purging of resources when a capture storage is full, it would not be clear to one of ordinary skill in the art how an object would be downloaded into a full capture storage without the generation of an error.

Additionally, Applicant's traversal of the rejection under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling is considered moot as Applicant has overcome the prior rejection with the present amended claim language found in claims 1 and 26.

Art Unit: 2161

Accordingly, the claim rejection under 35 U.S.C. 112 is sustained.

b. Rejections under 35 U.S.C. 102

Applicant asserts the argument that "Seto et al. fail to teach each and every element of claims 1 and 26 as amended. The Examiner respectfully disagrees and the Applicant is directed to the rejections of claims 1 and 26 as provided herein above.

Accordingly, the claim rejections under 35 U.S.C. 102 are sustained.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

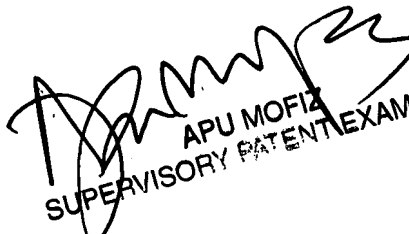
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Kim  
Patent Examiner, Art Unit 2161  
TECH Center 2100

  
APU MOFIA  
SUPERVISORY PATENT EXAMINER